

REMARKS

The final Office Action (the "Office Action") dated May 24, 2007 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto. The above-amendments to claims 1, 11, 14, 20, 23, add 34 and the following remarks are submitted as a full and complete response thereto. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-34 are pending and under consideration.

In the Office Action at section 5 through 6, claims 1 through 34 were rejected under 35 U.S.C. § 102(e) as being anticipated by U. S. Published Patent Application No. 20020077157 to Okun et al. (the "Okun" reference). The Office Action took the position that Okun describes all the recitations of independent claims 1, 11, 14, 20, 23, and 34 and their related dependent claims. Applicants respectfully traverse this rejection.

Independent claim 1, upon which claims 2-10 and 24-26 are dependent, recites a method, including detecting a call establishment request, in response to said detecting, alerting a called terminal, in response to said alerting, setting up a two-way connection between a calling terminal and the called terminal, determining that a two-way voice call between the calling terminal and the called terminal is not allowed, receiving silent messages via the called terminal and/or the calling terminal, and conveying said silent messages to the calling terminal and/or the called terminal, respectively.

Independent claim 11, upon which claims 12-13 and 27 are dependent, recites an apparatus, including a detecting unit configured to detect a call establishment request, an alerting unit configured to alert a called terminal in response to said call establishment request, and a setting up unit configured to set-up, in response to said alerting, a two-way connection between a calling terminal and the called terminal. The apparatus also includes a determining unit configured to determine that a two-way voice call between the calling terminal and the called terminal is not allowed, a receiving unit configured to receive silent messages via the called terminal, and a conveying unit configured to convey said silent messages to the calling terminal.

Independent claim 14, upon which claims 15-19 and 28 are dependent, recites an apparatus being configured to detect a call establishment request, in response to said detection, set up a two-way connection between a calling terminal and a called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, receive silent messages via the called terminal, and convey said silent messages to the calling terminal.

Independent claim 20, upon which claims 21-22 and 29 are dependent, recites a user interface in a called terminal and/or a calling terminal, wherein the user interface is configured to select a desired call mode, in response to said selection, setting up a two-way connection between the calling terminal and the called terminal, and if a two-way voice call between the called terminal and the calling terminal is not allowed, receive and convey silent messages from the calling terminal and/or the called terminal.

Independent claim 23, upon which claims 30 through 33 are dependent, recites a communication system configured to detect a voice call establishment request from a calling terminal to a called terminal, in response to said detecting, alert the called terminal, in response to said alert, set up a two-way connection between the calling terminal and the called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, and receive silent messages via said called terminal and/or calling terminal and convey said silent messages to the calling terminal and/or the called terminal, respectively.

Independent claim 34 recites a apparatus, including means for detecting a call establishment request, means for alerting a called terminal in response to said call establishment request, means for setting up, in response to said alerting, a two-way connection between a calling terminal and the called terminal, means for determining that a two-way voice call between the calling terminal and the called terminal is not allowed, means for receiving silent messages via the called terminal, and means for conveying said silent messages to the calling terminal.

As will be discussed below, Okun fails to disclose or suggest the elements of any of the presently pending claims as amended.

As described in its Abstract, Okun generally relates to:

A communication system constructed according to the present invention provides a method and apparatus for causing a message to be played to a calling party to indicate that the called party will be taking the call shortly. In each embodiment, a called party depresses a select key or button in a specified manner to indicate that the message should be played

to the calling party. The method may be performed by anyone of an SS7 or other IN network, a wireless network, a mobile station or a wireline phone. According to the type of phone, differing embodiments of the methods performed by the communication network may be realized. In the case of a mobile station, the entire method may be performed by it in one embodiment of the invention. Alternatively, if the phone is a wireline phone, the method may be performed solely by the wireline telephone network. In one embodiment of the present invention, the call is connected as normal but the message is played to advise the calling party that the called party will be taking the call shortly. In other embodiments, either the call is not completed until the called party indicates a readiness to take the call, or alternatively, the call is connected but placed on hold or simulated hold by muting one or more of the phone microphone and speaker until the called party indicates a readiness to take the call.

In view of this and other disclosure in Okun, it can be seen that the reference generally provides to a communication system in which a message is played to a calling party to indicate that the called party will be taking the call shortly. Specifically, the called party receives an indication of the call and depresses a selected key or button to indicate that a message should be played to the calling party. In one embodiment of Okun, the call is connected as normal but the message is played to advise the calling party that the called party will be taking the call shortly. In other embodiments, either the call is not completed until the called party indicates a readiness to take the call, or alternatively, the call is connected but placed on hold until the called party indicates a readiness to take the call. In summary, Okun allows a called party to receive notice of a requested incoming call and to return an audio message to the calling party refusing the call.

For example, in paragraph 41, Okun describes a scenario in which a called party is already engaged in a first call with a first calling party when a request for a second call is received. The called party receives a notice of the second call and may press a button on a telephone to cause a prerecorded message to be forwarded to the second calling party to refuse the second call. According to Okun, this functionality allows the called party to silently forward an audio message to the second caller without alerting the first calling party of the second incoming call.

In contrast, embodiments of the subject application generally enable a called party to receive notice that of an incoming audio communication and to respond to this incoming communication with a silent text message back to the calling party. In embodiments of the subject application, the silent text message may be either directly forwarded to the calling party or translated into an audio message and forwarded to the calling party.

In view of the above-described aspects of Okun, Applicants urge that Okun does not teach every limitation of the recited embodiments, and aspects of the subject application may be distinguished from the disclosure of Okun. To further clarify these differences and to expedite prosecution, Applicants herein amend claim 1 to recite that silent messages are conveyed between the called terminal and the calling terminal. In contrast, Okun teaches only the exchange of audio messages between the two terminals. For at least these reasons, Okun fails to teach or suggest all the recitations of amended

independent claim 1, and the rejection of claim 1 may be traversed through these amendments and remarks.

On similar grounds, dependent claims 2 through 10 should likewise be allowable as depending from allowable amended claim 1. Reconsideration and allowance thereof is respectfully requested.

Applicants similarly amend claims 11, 14, 20, 23, and 34 to recite the limitation that silent messages are conveyed between the called terminal and the calling terminal. Because independent claims 11, 14, 20, 23, and 34 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 14, 20, 23, and 34, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 14, 20, 23, and 34 and the claims depending therefrom.

As described in greater detail below, Applicants further note that Okun does teach recitations contained in several dependent claims. Accordingly, even if either the amended claims continue to be rejected in view of Okun or, alternatively, the entry of the proposed amendments is refused at this time, at least claims 3, 4, 8, 9, 10 12, and 17 should be separately allowable for the reasons provided below. If additional prior art references are needed to reject these and other claims in a new Office Action, that new Action must be non-final.

Referring now to claim 3, Applicants note that Okun does not teach the limitation that the step of determining whether a voice call is allowed comprises detecting a predetermined profile associated with the called terminal, where the profile is set prior to the call. For example, the subject application discloses the use of a rule that causes all incoming calls to be automatically refused with a silent reply message. In contrast, Okun provides, for example, in steps 310 and 508 that the called person must act to send a return message. In addressing claim 3, the Office Action states that the determining step, as implemented in Okun, may be based on a predetermined input from the user interface, which is not relevant to the recitation in claim 3 of using a predefined profile in the determining step. For at least these reasons, Applicants urge that claim 3 should be allowable since Okun does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Similarly, Applicants urge that Okun does not teach or suggest the recitations of claim 4. Claim 4 includes the limitation that the two-way connection is or comprises a chat connection. As described in the specification of the subject application and as well-known in telecommunications, chatting (also known as text messaging) refers to the sending of short text messages between mobile phones using the Short Message Service (SMS). There is no suggestion in Okun of any non-voice communications, let alone a chat connection. For at least these reasons, Applicants urge that claim 4 should be allowable since Okun does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Regarding dependent claim 8, Okun does teach the limitation that a plurality of predetermined voice messages is dimensioned such that any predetermined voice message is selectable without moving fingers on the user interface. In rejecting this claim, the Office Action cites to paragraph 17 of Okun. However, the cited section discusses that various functions may be activated by buttons on a telephone but does not discuss the positioning or layout of the activating buttons as recited in the claim 8. For at least these reasons, Applicants urge that claim 8 should be allowable since Okun does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Referring now to claim 9, Okun does not disclose or suggest the limitation that a network element performs the step of determining that the two-way voice call is not allow. As described above in claim 3, there is no automatic determining in Okun, which instead discloses that only the called party may refuse an incoming voice communication. In this way, the determining step in Okun is performed by the called party and not a network element. While the Action cites to elements of the communications network used in the voice call, these referenced elements do not participate in the determining step. For at least these reasons, Applicants urge that claim 9 should be separately allowable since Okun does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Likewise, claim 10 should also be separately allowable. Claim 10 contains the recitation that the converting of silent messages to speech is carried out by a network

element. The section of Okun cited in the Office Action mentions that a spoken message can be sent to the calling party, but in no way describes or suggests that a network element performs the text-to-speech conversion. Applicants respectfully disagree. Okun discloses, instead, that the corresponding element is present on the called terminal. For at least these reasons, Applicants urge that claim 10 should be separately allowable since Okun does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

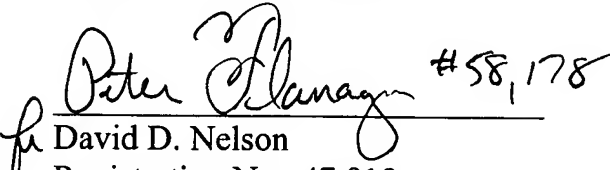
Applicant further urge that claim 12, which depends from independent claim 11, should also be separately allowable. Claim 12 contains the limitation that the various units recited in apparatus claim 11 are located on a network element. Despite the Office Action's assertions on page 4, Applicants find that Okun does not teach or suggest this limitation. In particular, Okun discloses only that the corresponding elements are likely present only on the called terminal and that the communications occur through the network elements. The Office Action should not interpret the called terminal as a network element since this interpretation is contrary to the usage of the terms in the telecommunications field and in the subject application, particularly since claim 13 separately recites locating the elements of claims 11 on the called terminal. For these and other reasons, Applicants submit that claim 12 should be separately allowable over Okun that does not teach or suggest all of the recited limitations. Reconsideration and allowance of claim 12 is respectfully requested.

Claim 17 contains the recitation that the claimed apparatus includes a mode converter configured to change a call from a voice call to a non-voice call. As described above in the discussion of claim 4 regarding the use of chatting in the subject application, Okun does not teach or suggest the use of text message or other non-voice calls, let alone describe the use of a mode converter as recited in claim 17. The Office Action argues that Okun teaches converting a silent message to a recorded voice message for transmission through a voice call to the calling terminal. Applicants note that this argument ignores that limitation of converting between a voice call and a non-voice call since Okun teaches to communicate only with a voice call. For at least these reasons, Okun does not teach the limitations of claim 17, and this claim should also be separately allowable as well. Reconsideration and allowance of claim 17 is respectfully requested.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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